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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,416	07/03/2001	Gary Schwenck	30010519-1	8322

7590 05/20/2005

LOWE HAUPTMAN GILMAN & BERNER, LLP
Suite 310
1700 Diagonal Road
Alexandria, VA 22314

EXAMINER

LIPMAN, JACOB

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/897,416	Applicant(s) SCHWENCK ET AL.	
	Examiner Jacob Lipman	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-22 and 48 is/are rejected.
- 7) ☒ Claim(s) 5 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/11/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Claims 23-47, 49, and 50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 28 February 2005.
2. Applicant's election with traverse of claims 1-22 and 48 in the reply filed on 28 February 2005 is acknowledged. The traversal is on the ground(s) that there would be no serious burden to the examiner. This is not found persuasive because searching all the inventions would require extensive extra searching, which would be a burden on the examiner. For example, Applicant mentions the time-stamping method of claim 50 is a specific method of providing the trusted date output of claim 49. Claim 49 does not include a trusted clock as part of the module, but clock data could be received from external sources. Claim 50 does not include the tamper checking of claim 49.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

3. The examiner has considered the information disclosure statement (IDS) submitted on 11 December 2002.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "substantially" and "sufficiently" in claims 15 and 20 are relative terms which render the claims indefinite. The terms are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4, 8-17, 20, and 22, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Candelore, US patent number 5,861,662.

With regard to claim 1, Candelore discloses a tamper resistant electronic module (column 2 lines 49-50) comprising a tamper en electronic component (column 2 lines 50-51), a tamper resistant sheet (column 2 lines 61-64), and encapsulant material (column 2 lines 54-56). Wherein the sheet comprises a tell-tale conductive trip (column 2 lines 57-64) which covers the component (column 8 lines 1-11) and an electronic radiation shield layer (column 5 lines 13-22).

With regard to claims 2 and 3, Candelore discloses the layers are coated with plastic (column 5 lines 39-42).

With regard to claim 4, Candelore discloses the tamper resistant sheet is encapsulated in the material (column 2 lines 49-56).

With regard to claim 8-10 and 22, Candelore discloses using a PCI card (column 3 lines 45-47), which is not precisely flat.

With regard to claims 11, 14, and 15, Candelore discloses encapsulating a portion of the smart card extends the wire above and below the component (column 7 lines 51-57).

With regard to claims 12 and 13, Candelore discloses multiple layers (column 5 lines 12-30) which are also separate sheets.

With regard to claims 16 and 17, Candelore discloses having a power supply and sensor (column 5 lines 13-17).

With regard to claim 20, Candelore discloses having a breakable material, which will break or crack if drilling is attempted (column 5 lines 39-48).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 18, 19, 21, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore.

With regard to claim 6, Candelore discloses group ii and group i, as outlined above, but does not specifically mention sandwiching group ii within two layers of group i. Candelore does disclose locating the shield (group I) within the encapsulation layer, and having multiple layers (column 5 lines 22-25). Having the layer of group ii between the disclosed multiple layers of group i is seen as an obvious configuration. It would have been obvious for one of ordinary skill in the art to use this configuration to separate the layers on group I, and protect each layer with a group I layer.

With regard to claims 18, 19, and 48, Candelore discloses the module of claim 17, as outlined above, but does not disclose time-stamping the tamper attempt. The examiner takes official notice that tampering attempts are typically time stamped. It would have been obvious for one of ordinary skill in the art to timestamp a tamper attempt in Candelore to help investigate system vulnerability.

With regard to claim 21, Candelore discloses the module of claim 20, as outlined above, but does not disclose specifically making the sheet resistant to laser. The examiner takes official notice that lasers are well known cutting devices. It would have been obvious for one of ordinary skill in the art to protect against lasers in addition to the breaking methods already protected by Candelore.

Allowable Subject Matter

10. Claims 5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 5 and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

With regard to claim 5, Candelore discloses the module of claim 4, as outlined above, but does not specifically mention the encapsulating material being opaque. Candelore does not provide motivation to make the tamper resistant sheet hidden, and thus it would not have obvious to one of ordinary skill in the art to make this modification.

With regard to claim 7, claim 6 would be obvious over Candelore, as outlined above, but the further details of claim 7 are not seen as obvious to one of ordinary skill in the art, since it is not an obvious configuration.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3837. The examiner can normally be reached on M-Th 7 AM-3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL

A handwritten signature in black ink, appearing to read 'Greg Morse', is positioned above the printed name.

**GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**